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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,850	09/22/2006	Philippe Moser	C 2939 PCT/US	4436

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EXAMINER	
WINSTON, RANDALL O	
ART UNIT	PAPER NUMBER
1655	

NOTIFICATION DATE	DELIVERY MODE
03/28/2012	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/593,850	MOSER ET AL.	
	Examiner	Art Unit	
	RANDALL WINSTON	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 October 2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) *10,12,13,15 and 22-31* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *10,12,13,15 and 22-31* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/04/2011 has been entered.

Claims 10, 12-13, 15 and 22-31 have been examined on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10, 12-13, 15 and 24 are rejected under 35 USC 102(b) as being anticipated by the admitted state of the art for the reasons set forth in the previous office action. New claim 31 is also rejected under 35 USC 102(b) as being anticipated by the admitted state of the art.

Applicant claims a method for the treatment of the skin and/or skin disorders comprising the steps of administering to a patient in need thereof a composition

comprising an effective amount of a plant extract wherein the plant extract is obtained from extracting the fruit and/or seed of the *Buchholzia coriacea* with a solvent such as water.

As readily admitted by Applicant, a composition comprising a water extract solution (please note that water is an art-recognized pharmaceutical auxilliary/additive) from the seeds of the *Buchholzia coriacea* has effectively been used in the prior art to treat earaches (which would inherently be a skin inflammatory condition) via topical application thereto (please note also when the composition is topically applied to the skin, it would inherently treat skin aging in any and/or all patients because all skin is considered aged). In addition, as readily admitted by Applicant, a composition comprising a fruit extract from *Buchholzia coriacea* (e.g., in the form of a fruit pulp) has been effectively used in the prior art to treat back pain (please also note that back pain is commonly associated with skin inflammation) via topically massaging such a fruit extract thereto (please note also when topically the composition is applied to the skin, it would inherently treat skin aging in any and/or all patients because all skin is considered aged and would show some sign of aging) (see, e.g., last paragraph on page 2 of the instant specification). Also, please note that the instantly claimed *in vivo* functional effects (if not expressly admitted) would be inherent upon such topical administration/application to the skin (please note the *in vivo* functional effect of treating aged skin when topically applied).

Therefore, the admitted state of the art is deemed to anticipate the claimed invention.

Applicant's argument has been carefully considered but it is not deemed persuasive. Applicant argues that the prior art is devoid of any showing that the composition is topically applied to aged skin. However, the Examiner maintains that the instantly claimed *in vivo* functional effects (if not expressly admitted) would be inherent upon such topical administration/application of the same claimed composition to the skin (please note the *in vivo* functional effect of treating aged skin when topically applied).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10, 12-13, 15 and 22-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted state of the art in view and Sawai et al. (JP 62161724A, see entire article).

Applicant claims a composition and/or method comprising the steps of administering to a patient in need thereof a composition comprising an effective amount of a plant extract wherein the plant extract is obtained from extracting the fruit and/or

seed of the *Buchholzia coriacea* with a solvent such as water and other claimed active ingredients therein (i.e. an additional additive and/or auxiliary) to be administered (i.e. orally or topically in claimed forms) in effective amounts to a patient in need thereof for the treatment of the skin and/or skin disorders (i.e. a skin disorder such as skin inflammatory conditions and/or aged skin).

As readily admitted by Applicant, a composition comprising a water extract solution (please note that water is an art-recognized pharmaceutical auxilliary/additive) from the seeds of the *Buchholzia coriacea* has effectively been used in the prior art to treat earaches (which would inherently be a skin inflammatory condition) via topical application thereto (please note also when the composition is topically applied to the skin, it would intrinsically have an inhibitory effect to treat skin aging in any and/or all patients because all skin is considered aged). In addition, as readily admitted by Applicant, a composition comprising a fruit extract from *Buchholzia coriacea* (e.g., in the form of a fruit pulp) has been effectively used in the prior art to treat back pain (please also note that back pain is commonly associated with skin inflammation) via topically massaging such a fruit extract thereto (please note also when the composition is topically applied to the skin, it would intrinsically have an inhibitory effect to treat skin aging in any and/or all patients because all skin is considered aged) (see, e.g., last paragraph on page 2 of the instant specification). Also, please note that the instantly claimed *in vivo* functional effects (if not expressly admitted) would be intrinsic upon such topical administration/application to the skin (please note the *in vivo* functional effect of having an inhibitory effect to treat aged skin when topically applied). Applicant's

specification, however, does not teach within its composition and/or method to include an additional claimed skin additives therein to be administered topically on the skin in effective amounts to a patient in need thereof for the treatment of skin inflammatory conditions.

Sawai benefically teaches a well known skin additive such as a polymer carrier for a formulation as a stabilizer to be applied to the skin that has anti-inflammatory activity (see, e.g. entire document including e.g. page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the therapeutic *Buchholzia coriacea* seed and/or fruit extract preparations admittedly known in the prior state to include an additional well known skin additive/auxilliary such as those instantly claimed, including a polymer as taught by Sawai because the above combined cited references as a whole would create the claimed composition and/or method comprising the steps of administering to a patient in need of a composition comprising an effective amount of a plant extract wherein the plant extract is obtained from extracting the fruit and/or seed of the *Buchholzia coriacea* with a solvent such as water as well as to include other well known skin additives therein to be administered topically on the skin in effective amounts to a patient in need thereof for the treatment of skin inflammatory conditions. Also, please note that the instantly claimed *in vivo* functional effects (if not expressly admitted) would be intrinsic upon such topical administration/application to the skin (please note the *in vivo* functional effect of having an inhibitory effect to treat aged skin when topically applied). The result-effective adjustment of conventional working conditions (e.g.,

incorporating one or more conventional skin additives and/or auxilliaries such as those instantly claimed to such a topical therapeutic composition, determining a suitable amount/range of the active ingredients within the claimed composition depending on how much the patient's skin is inflamed, and/or treating a particular type of back pain such as that commonly caused by inflammation - including arthritic back pain) is deemed a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Accordingly, the invention as a whole is prima facie obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

Applicant's argument has been carefully considered but it is not deemed persuasive. Applicant argues that with respect to the Examiner's obviousness rejection of the claims, the Court in Nicholas v. Perricone M.D., 432 F.3d 1368,1378 (Fed. Cir. 2005) found that the treatment of skin sunburn was not analogous to preventing sunburn, and therefore, a topical composition for treating skin sunburn was a patentable new use of an old product. Anaglogously with respect to the present claims, the Office Action's allegation regarding the inherently functional effects of Applicant's claimed invention goes astray because the Office Action is assuming what the prior art neither discloses not renders inherent. The prior art is devoid of any language suggesting topical application to aged skin to provide an anti-ageing effect. However, all skin is aged and the application to the skin of the extract of the instant claims for any reason

(including to treat inflammation) is treating aged skin. Examiner maintains that the instantly claimed *in vivo* functional effects (if not expressly admitted) would be intrinsic upon such topical administration/application of the same claimed composition to the skin (please note the claimed composition is considered an old product). Also please note that although Applicant argues that aged skin is a new use, the claimed composition that is considered an old product would also have the *in vivo* functional effect of having an inhibitory effect to treat aged skin when topically applied for inflammation).

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RANDALL WINSTON whose telephone number is (571)272-0972. The examiner can normally be reached on 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RW

/Melenie McCormick/

Primary Examiner, Art Unit 1655